

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TTAB

In re Application of

chaotic.com, inc.

Serial No.: 78/631,806

Filing Date: May 17, 2005

Publication Date: October 24, 2006

Mark: ONE-PING

Pending in Classes: 09; 41 and 42

Opposition No. 91175759

RESPONSE TO OPPOSITION

BOX TTAB FEE

Assistant Commissioner of Trademarks

2900 Crystal Drive

Arlington, VA 22202-3513



04-02-2007

U.S. Patent & TMO/TM Mail Receipt #01

**ANSWER TO KARSTEN MANUFACTURING
CORPORATION'S NOTICE OF OPPOSITION**

COMES NOW the applicant chaotic.com, inc. ("Applicant"), by and through its attorney, Andrew F. Reish of David, Brody & Dondershine, LLP, and answers Karsten Manufacturing Corporation's "Notice of Opposition" as follows:

Applicant chaotic.com, inc. denies that Karsten Manufacturing ("Opposer") will be damaged by registration of U.S. Application Serial No. 78/631806 for the mark ONE-PING, as used for "COMPUTER SOFTWARE FOR DETECTING AND CLASSIFYING OBJECTS IN BODIES OF WATER FOR USE IN THE FIELD OF SONAR AND SONAR SYSTEM," in International Class 9. Applicant further denies that Opposer will be damaged by registration of the Mark ONE-PING, as used for "EDUCATION, NAMELY, TRAINING SERVICES IN THE FIELD OF OPERATING SONAR AND SONAR SYSTEMS," in International Class 41. Applicant further denies that opposer will be damaged by registration of the Mark ONE-PING,

as used for "TECHNICAL AND ENGINEERING COUNSULTING SERVICES IN THE FIELD OF DEFENSE, NAMELY, SONAR SIGNAL PROCESSING ANALYSIS AND SONAR SYSTEMS ANALYSIS," in International Class 42. Applicant denies all allegations and inferences arising from any remaining statements in the Opposer's introductory paragraph.

Applicant admits that Opposer is the owner of U.S. Trademark Registration Nos. 3,171,974; 2,809,860; 2,909,185; 2,810,552; 3,171,975; 2,936,630; 1,638,323; 3,174,437; 1,647,448; 2,810,551; 2,733,222; 2,909,186; 2,822,249; 2,909,187; 2,998,878; 2,909,188; 2,823,210; 1,637,647; 2,810,550; 2,810,601; 3,199,155; 3,171,976; 3,177,633; 704,552; 1,632,445; 2,923,069; 3,171,977; 1,633,477; 2,870,863 for the mark PING. Applicant qualifiedly admits that those registrations authorize the use of the mark PING, but only for use on "sun block" in International Class 03, "metal key rings" in International Class 06; "pocket knives" in International Class 08; "computer carrying cases" in International Class 9; "on refrigerator magnets, calculators" in International Class 09; "men's and women's watches" in International Class 14; "newsletters on professional golf" in International Class 16; "notebooks, ball-point pens, pencils, appointment books, calendars and day planners" in International Class 16; "golf accessories, namely, umbrellas and traveling bags" in International Class 18; "travel document cases and toiletry cases sold empty" in International Class 18; "travel covers for golf bags, leather gloves and belts made of leather, back packs fanny packs, brief cases, garment bags and show bags for travel, valuable pouch, and duffels bags" in International Classes 18, 25 and 28; "chairs" in International Class 20; "plastic water bottles sold empty" in International Class 21; "mugs" in International Class 21; "wastepaper baskets" in International Class 22; "lanyards for holding eyeglasses" in International Class 22; "towels" in International Class 24; "clothing, namely shirts, caps sweaters, and sun visors" in International Class 35; "mittens" in International

Class 25; “caps and visors” in International Class 25; “slacks, shorts, skorts, sweatshirts, windshirts, woven shirts, sweater vests, jackets, belts, rainwear, and socks” in International Class 24; “embroidered emblems” in International Class 26; “rugs” in International Class 27; “golf clubs” in International Class 28; “sporting goods, namely, golf bags, golf balls, and head covers for golf clubs” in International Class 28; “drinking water” in International Class 32; “sponsoring golf Professionals” in International Class 41; and “training and educating sporting goods dealers to fit golf clubs to customers, golf club fitting, sponsoring amateur golf tournaments for men, women and for junior golfers, and sponsoring professional golf tournaments” in International Class 41. Applicant denies the remainder of the allegations in this paragraph and any inferences arising therefrom.

2. Applicant admits the averments of Paragraph 2.

3. Applicant admits only with respect to the PING marks listed in Opposer’s Paragraph 3 that all have registration and/or application dates that are prior to the filing date of the Applicant’s Mark ONE-PING. Applicant is without sufficient information to admit or deny the allegation that “[m]any of the PING marks are incontestable.” Accordingly the allegation as to such incontestability is denied.

4. Applicant is without sufficient information to admit or deny the allegations. Accordingly, the allegations are denied.

5. Applicant is without sufficient information to admit or deny the allegation. Accordingly, the allegation is denied.

6. Denied.

AFFIRMATIVE DEFENSES

Applicant raises the following affirmative and other defenses:

1. Applicant's use of the mark ONE-PING, when used on the goods and services set forth in Applicant's application, poses *no* risk of public confusion, and no grounds therefore exist to refuse registration of U.S. Application Serial No. 78/631,816 for the mark ONE-PING. This lack of likelihood of public confusion is supported by the fact that Opposer's PING mark is asserted as used exclusively on consumer or entertainment goods and services, whereas Applicant's ONE-PING mark is used exclusively on goods and services related to the highly technical field of sonar and sonar systems, namely, computer software, training services in such field as well as technical and engineering consulting services in sonar signal processing analysis and sonar systems analysis. Thus, the ONE-PING mark is marketed within and reaches an entirely separate market from the PING marks listed in Opposer's Paragraph 3.

2. Applicant's use of the ONE-PING mark is not likely to dilute the asserted distinctiveness of the PING marks listed in Opposer's Paragraph 3.

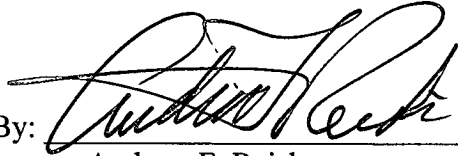
3. Applicant's ONE-PING mark is not primarily merely descriptive of the goods and services described in the application for the ONE-PING mark, but rather fanciful, arbitrary or suggestive.

4. Applicant's use of the ONE-PING mark constitutes a fair use.

WHEREFORE, Applicant prays for an Order dismissing this Opposition and granting registration of the ONE-PING mark, and for such other relief as may be proper.

Respectfully submitted,

chaotic.com, inc.

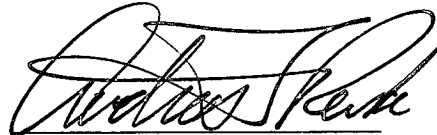
By: 

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer has been served by mailing said copy on the 30th day of March, 2007, via overnight delivery, postage prepaid to the following counsel for plaintiff Opposer:

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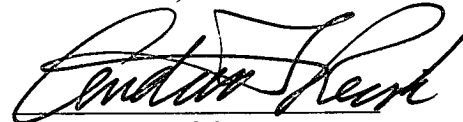

Andrew F. Reish

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

on March 30, 2007


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